REMARKS

Claims 1-14 are pending in the present application.

This Amendment is in response to the Office Action mailed October 30, 2003. In the Office Action, the Examiner objected to claim 3, rejected claims 13 and 14 under 35 U.S.C. § 112 - second paragraph, rejected claims 1-5 and 14 under 35 U.S.C. § 102(e), and rejected claims 6, 12 and 13 under 35 U.S.C. § 103. Applicant has amended claims 1-14 to correct informalities and not for any reason whatsoever related to the patentability of the claims. Applicant submits that no new matter has been added. Reconsideration in light of the amendments and remarks made herein is respectfully requested.

I. FORMS PTO-1449

Applicant notes that the Examiner did not initial all of the references listed on the Form PTO-1449 as filed on December 4, 2001 (copy enclosed). Applicant kindly requests that the Examiner sign and initial a copy of the two references which were not initialed on the Form PTO-1449 filed on December 4, 2001. Copies of the two references are enclosed.

In addition, Applicant kindly requests that the Examiner sign and initial a copy of the Form PTO-1449 as electronically filed on October 7, 2003 (copy enclosed). Applicant further requests that a signed and initialed copy of the PTO-1449 forms be returned to Applicant's mailing address to complete Applicant's records.

II. CLAIM OBJECTION

The Examiner objected to claim 3 because of the informalities. Applicant has amended the claim accordingly. Therefore, Applicant requests the objection be withdrawn.

III. REJECTION UNDER 35 U.S.C. § 112

The Examiner rejected claims 13 and 14 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, which Applicants regard as the invention. Applicant has amended claims 13 and 14 accordingly. Therefore, Applicant requests that the rejection be withdrawn.

IV. REJECTIONS UNDER 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 1-5 and 14 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,035,329 issued to Mages et al. ("Mages"). Applicant respectfully traverses the rejection for the following reasons.

Inventor X discloses method and system for playing back DVD-ROMs which system discriminates between DVD-ROMs requiring pay-per-view play, and those do not, by the use of a special code for the header of the DVD-ROM indicating a pay-per-view title or by the use of an ATM card (Mages, Col. 2, lines 45-56). The method discloses determining that the DVD-ROM is a Hyper-DVD, that is, a pay-per-view DVD (Mages, Col. 3, lines 43-45). The Hyper-DVD is read, analyzed, and the critical information thereof is extracted. The critical, or enabling, data for allowing access may be missing heading, password, ID, security methods, or standard verification keys ... (Mages, Col. 4, lines 6-19). Mages, however, does not disclose the determining of a characteristic and the two indices where the first indicia corresponds to an identifier of the recording medium and the second indicia identifies a device.

To support a 102 rejection, the Examiner must show that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bro. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987), (MPEP §2131). In addition,

"[t]he identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989), (MPEP §2131). Here the Examiner has not pointed out the specific language in Mages that teaches the determining a characteristic of the storage medium based upon one of the two indices.

Mages, taken alone or in any combination, does not disclose, suggest, or render obvious the determining a characteristic of the recording medium based upon one of the two indices.

Since the Examiner has failed to show the identical invention in as complete detail as is contained in the claim, the rejection under 35 U.S.C. §102(e) was improperly made. Therefore, Applicant respectfully requests that rejection be withdrawn.

V. REJECTIONS UNDER 35 U.S.C. § 103

The Examiner rejected claims 6, 12, and 13 under 35 U.S.C. § 103(a) as being unpatentable over Mages in view of U.S. Patent No. 4,658,093 issued to Hellman ("Hellman"). The Examiner rejected claims 7-9 under under 35 U.S.C. § 103(a) as being unpatentable over Mages in view of U.S. Patent No. 6,332,126 issued to Peirce ("Peirce"). The Examiner rejected claims 10 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Mages in view of U.S. Patent No. 6,260,758 issued to Blumberg ("Blumberg"). Applicant respectfully traverses the rejections for the following reasons.

Hellman discloses a software that can be authorized for use a given number of times by a base unit after which the base unit cannot use that software until the manufacturer sends an authorization for additional used to the user's base unit (Hellman, Abstract line 11-14 and Col. 4, lines 21-26). Hellman, however, does not disclose the determining a characteristic of the recording medium based upon one of the two indices.

Peirce discloses system and method for a targeted payment system discount program. The system and method utilizes five basic steps: (1) an automated process which enables the merchant to target consumers, (2) an automated process which matches targeted merchant offers against a data base of consumers, (3) an automated process which provides the consumer with the best value, (4) the ability for the consumer to act on value proposition, and (5) an automated process which reports on the execution of the discount transaction (Peirce, Col. 2, lines 15-46). Unlike the present invention Peirce does not disclose the determining a characteristic of the recording medium based upon one of the two indices.

Blumberg discloses a promotional financial transaction machine method. The patron-interactive promotional section of the promotional receipt can include any of a variety of rewards to the patron (Blumberg, Col. 5, line 65 to Col. 7, line1). There is nowhere in Blumberg that discloses the determining a characteristic of the recording medium based upon one of the two indices.

Mages, Hellman, Peirce, and Blumberg, taken alone or in any combination, do not disclose, suggest, or render obvious the determining a characteristic of the recording medium based upon one of the two indices.

Therefore, Applicant believes that independent claim 1 and their respective dependent claims are distinguishable over the cited prior art references. Accordingly, Applicant respectfully requests the rejections under 35 U.S.C. § 103(a) be withdrawn.

CONCLUSION

In view of the amendments and remarks made above, it is respectfully submitted that the pending claims are in condition for allowance, and such action is respectfully solicited. If it is believed that a telephone conversation would expedite the prosecution of the present application, or clarify matters with regard to its allowance, the Examiner is invited to contact the undersigned attorney at the number listed below.

Respectfully submitted,

DISCOVISION ASSOCIATES

Dated: January 7, 2004

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